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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,413	01/22/2004	Ian Peek	2810	4528

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STRIKER, STRIKER & STENBY
103 East Neck Road
Huntington, NY 11743

EXAMINER

LEGESSE, NINI F

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/762,413

Applicant(s)

PEEK, IAN

Examiner

Nini F. Legesse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Applicant's response to the Office Action of 07/28/04 is acknowledged on 10/08/04.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 10 stand rejected under 35 U.S.C. 102(b) as being anticipated by Hesselbart (US Patent No. 5,013,044).

- **With respect to claim 1**, Hesselbart discloses an upright rack (76); a rod (78) provided on said rack (76) and aligned substantially horizontally and parallel to a desired hitting direction, said rod being arranged at a distance to said rack such that a golf club is swingable through underneath said rod (refer to Fig. 1).
- **With respect to claim 2**, an extension (88) connecting said rod with said rack so as to hold said rod at said distance to said rack.
- **With respect to claim 3**, the rod is disposed substantially at a height of a forearm of a golfer (see Fig. 1).
- **With respect to claim 10**, the rod (78) and said rack (76) are dismountable from one another (as shown on Fig. 2, the wing set screws 94, 96, and 102 provide the capability of dismounting the rod and the rack elements).

Claims 1-3, 8, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Tarulli et al. (US Patent No. 6,343,998).

- **With respect to claim 1**, Tarulli discloses an upright rack (41); a rod provided on said rack and aligned substantially horizontally (57,61) and parallel to a desired hitting direction (see Fig. 2), the rod being arranged at a distance to said rack such that a golf club is swingable through underneath said rod (the structure as shown on Fig. 1 is capable of being used for the function specified in this claim).
- **With respect to claim 2**, an extension (61) connecting said rod with said rack so as to hold said rod at said distance to said rack.
- **With respect to claim 3**, the rod is disposed substantially at a height of a forearm of a golfer (since the device is adjustable, the rod element 61 is capable of being positioned at a height of a forearm of a golfer).
- **With respect to claim 8**, the rack is adjustable in height (column 3, lines 20-24).
- **With respect to claim 9**, the extension is arranged extendably on said rack (see Fig. 1).

Claims 1, 4, and 5 stand rejected under 35 U.S.C. 102(b) as being anticipated by McKinney (US Patent No. Des. 324,554).

- **With respect to claim 1**, McKinney discloses an upright rack (the vertical element as shown on Fig. 1); a rod provided on said rack and aligned substantially horizontally (the horizontal element as shown on Fig. 1) and parallel to a desired hitting direction (see Figs. 1-6), the rod being arranged at a distance

to said rack such that a golf club is swingable through underneath said rod (the structure as shown on Figs. 1-6 is capable of being used for the function specified in this claim).

- **With respect to claims 4 and 5**, the rod as shown on Fig. 1 and the extension that is shown as an elbow on Figs. 5-6 connecting the vertical rack element and the horizontal rod elements is also inflatable.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over McKinney in view of Shute (US Patent No. 2,592,347).

McKinney discloses the invention as recited above but fails to show an air pump wherein said air pump is manually operatable. However Shute teaches that the use of a manual pump (7) to inflate elements (see item 5 in Figs. 1-4) is not new. Thus, it would have been obvious to one of ordinary skill in the art to provide a pump in the McKinney device as taught by Shute in order to be able to readily and easily inflate the device for usage.

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Claim 11 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Elson (US Patent No. 3,768,501). Elson discloses an upright rack made of a rigid material (33) and an inflatable rod provided on said upright rack aligned substantially horizontally and parallel to a desired hitting direction (see Fig. 1). In the alternative the claim is also rejected under 103. If it is argued that the Elson device is not a golf training apparatus, then it should be noted that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations and the Elson's device is obviously capable of being used as a training apparatus.

Response to Arguments

Applicant's arguments filed 10/08/04 have been fully considered but they are not persuasive.

Applicant argues that the rod 78 of the Hesselbart's reference is not provided at a distance to the rack. Please refer to Fig. 2 of the reference wherein rod 78 is shown off center at a distance from the rack element 76.

Applicant argues that the rod of Hesselbart is not aligned parallel to a desired hitting direction because it is shown at an angle on Fig. 1. Please note that the device is adjustable and even though it is shown at a distance on Fig. 1, if the golfer moves at a different location then the rod will clearly be parallel to the desired hitting direction.

In response to applicant's argument that the cited prior art serve different purpose, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nini F. Legesse whose telephone number is (571) 272-4412. The examiner can normally be reached on 9:30 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (571) 272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NFL

11/23/04


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